

No. 02-07, January 15, 2007

The **19<sup>th</sup> ECTA OHIM-Link** meeting will take place in Alicante on **February 5, 2007**.

Should you have any issues to be raised at this meeting, would you please send an e-mail, ASAP, to João Pereira da Cruz, Chair of the OHIM-Link Committee, at: [jpcruz@mail.telepac.pt](mailto:jpcruz@mail.telepac.pt) and/or to Sandrine Peters, ECTA Legal Co-ordinator at: [Sandrine.peters@ecta.org](mailto:Sandrine.peters@ecta.org) by January 5, 2007.

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If you would like to publish an Article in ECTA's Gazette, please note that the deadline for submission for the next publication is **March 1, 2006**.

Articles should be sent to Sandrine Peters at: [sandrine.peters@ecta.org](mailto:sandrine.peters@ecta.org).

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## 1. LAW

### DOMAIN NAME

#### Liberalization in ccTLD .ee

The administrator of ccTLD .ee has announced the plans to liberalize the existing regulation applicable to domain names under .ee ccTLD. The new Rules (Rules) are under preparation and will be published for public consultation as soon as the preparations in this respect will be finalized. According to the plans, the currently valid limitation for one domain name per person and probably the requirement for the local presence will be abolished. Moreover, the annual fees for domain name registrations will be established. Also the Rules will introduce the ADR procedure for domain name disputes. The major concern is that in the current stage the Rules do not foresee any Sunrise period for the owners of earlier rights applying for the domain name registrations once the Rules will come into force. As mentioned, the Rules are under preparation and some changes in the aforementioned aspects may be passed.

Riina Pärn, Member of the Internet Committee, Intels, EE

## 2. OFFICE PRACTICE

### DOMAIN NAME

.eu

#### Eurid advises that:

The inclusion of Romania and Bulgaria into the European Union on January 1<sup>st</sup> has prompted EURid to similarly expand the range of languages in which it offers support. People wishing to contact the registry may now also do so in the official languages of the 2 new member states, Romanian and Bulgarian. The telephone numbers to call to receive support in one of these languages are as follows:

Romanian/ Română : + 32 (0)2 401 27 79  
Bulgarian/ БЪЛГАРСКИ: + 32 (0)2 401 27 80

Eurid's communication can be found at: <http://www.eurid.eu/en/general/news/language-support-for-romanian-and-bulgarian>

### TRADE MARKS

#### CTM – Cooling-off

In this Flash edition we are publishing the results of the Survey carried out in respect of the cooling-off period. The results can be found on ECTA's website under the [OHIM-Link/Papers](#) section.

The comments reproduced in full will be presented to the OHIM during the next meeting of the ECTA-OHIM Link in Alicante on February 5, 2007.

Once again, we wish to thank all the Members who have kindly sent us their comments, which will contribute to better understanding the needs of Users, for the benefit of an improvement in the system.”

João Pereira da Cruz, Chair of the OHIM-Link Committee, J. Pereira da Cruz S.A. PT

### **CTM – E-Filing availability incidents**

OHIM inform users that there are some E-Filing incidents and that:

After completing the first page of the CTM application form, you may encounter an error page “The application is currently unavailable”. If this message appears, please try to e-file your application later. The Office is working to ensure full availability of the e-filing CTM system as soon as possible. Should you have an urgent filing, please contact us at:

[e-businesshelp@oami.europa.eu](mailto:e-businesshelp@oami.europa.eu)

### **CTM – Draft Cancellation Guidelines**

The Law Committee of ECTA provided OHIM with comments on the Draft Cancellation Guidelines. The comments can be found on ECTA’s website under the [Law Committee/Papers](#) section.

### **CTM – Draft Guidelines on International Marks**

OHIM notifies that Changes have been made in a number of parts of what used to be Chapter 13 of the Examination Guidelines and new parts have been added.

Comments can be provided by no later than March 12, 2007. The process of formal adoption of revisions of the guidelines will be finalised in 2007.

The document can be found at: <http://oami.europa.eu/EN/mark/marque/direc.htm#MP>

ECTA will provide comments and please send your comments to Doris Bandin, Chair of the Law Committee at: [db@elzaburu.es](mailto:db@elzaburu.es) and/or Sandrine Peters, ECTA Legal Coordinator at: [sandrine.peters@ecta.org](mailto:sandrine.peters@ecta.org).

## **3. CASE LAW**

To reach the **ECTA Info Database** including the **free Darts Europe** Case Law database, please click [here](#)



### **FRANCE**

The “Tribunal de grande instance de Paris” rendered two decisions applying article 100 CTMR.

This article relates to the case where hearing a case on an infringement of a CTM, the CTM Court notices that an action for a declaration of invalidity has already been filed before OHIM, or another CTM Court.

Article 100.1 CTMR provides that:

*“A Community trade mark court hearing an action referred to in Article 92, other than an action for a declaration of non-infringement shall, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office.”*

**1. Case No:** 05/17476

**Date:** October 17, 2006

**Parties:** Sothys International v Société Européenne des Produits de Beauté

**Decision:**

On November 22 2005, Sothys International files an infringement action of its CTM CELLU-GUARD against Société Européenne des Produits de Beauté.

A few days before, knowing that the infringement action was going to be filed shortly, Société Européenne des Produits de Beauté filed an invalidity action of said CTM at the OHIM. It, therefore, asked the court to stay the proceedings in accordance with article 100 CTMR.

The Court refuses to stay the proceedings, as, in the specific case, there are special grounds for continuing the hearing.

It considers that the invalidity action filed at the OHIM is purely a delaying tactic, as Société Européenne des Produits de Beauté filed its invalidity action only a few days before the infringement action and that it could have noticed the invalidity of the CTM at the time the cease and desist letter was received, namely a few months earlier. It further notices that the counterfeited goods are still on the market.

**1. Case No:** 06/00079

**Date:** October 17, 2006

**Parties:** Nestlé v Weider Fitness

**Decision:**

Nestlé filed an infringement action of its CTM FITNESS against the German company Weider Germany and its French affiliated company Weider Fitness.

After the filing of this action, the defendants filed an invalidity action of Nestlé's CTM at the OHIM and ask the court to stay the proceedings in accordance with article 100 CTMR.

The court rejects the request as article 100 CTMR only applies where the invalidity action has been filed before the filing of the infringement action.

Further, the court states that by choosing to file an invalidity action at the OHIM rather than filing a counterclaim in the existing procedure, the defendants provide for a delaying tactic which can not be admitted.

To find the full text of the national decisions mentioned in ECTA Flashes, please search the **ECTA Info Database** including the free Darts Europe Case Law database available on ECTA's website in the members' only section.

## 4. ECTA NEWS

### Madrid System

The third session of the Ad Hoc Working Group on the Legal Development of the Madrid System for the International Registration of Marks at WIPO will take place from January 29 to February 2, 2007.

ECTA will be represented by Jan Wrede (Member of the Law Committee) and Sandrine Peters (ECTA Legal Co-ordinator).

### 19<sup>th</sup> ECTA OHIM-Link

The 19<sup>th</sup> ECTA OHIM-Link meeting will take place in Alicante on **February 5, 2007**.

Should you have any issues to be raised at this meeting, would you please send an e-mail, to João Pereira da Cruz, Chair of the OHIM-Link Committee, at: [jpcruz@mail.telepac.pt](mailto:jpcruz@mail.telepac.pt) and/or to Sandrine Peters, ECTA Legal Co-ordinator at: [Sandrine.peters@ecta.org](mailto:Sandrine.peters@ecta.org) by January 5, 2007.

### 2007 Joint Meeting

The 2007 Joint Meeting with APRAM, BMM, ECTA, GRUR, ITMA and MARQUES will take place in Copenhagen (Denmark) on March 1, 2007.

### 14<sup>th</sup> OAMI Users Group

The 14<sup>th</sup> OAMI Users Group meeting will take place in Alicante on March 9, 2006.

Should you have any issues to be raised at this meeting, please send an e-mail to: Joao Pereira da Cruz (Chairperson of the OHIM link Committee) at: [jpcruz@mail.telepac.pt](mailto:jpcruz@mail.telepac.pt), and/or Sandrine Peters (ECTA Legal Co-ordinator) at: [Sandrine.peters@ecta.org](mailto:Sandrine.peters@ecta.org).

### Round Table

ECTA is organizing a Round Table on Design at the VITRA Kongresszentrum, at Weil am Rhein on March 23, 2007.

The provisional working title is

**“ The Community Design  
in particular relation to Austria, France, Germany and Switzerland”.**

Further details will be made available soon on ECTA's website under the “Conference/Round Tables” section.